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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,852	01/07/2002	Michael T. Prikas	YOR920010705US1	6571

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EXAMINER	
MARKOFF, ALEXANDER	

ART UNIT	PAPER NUMBER
1746	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,852	PRIKAS ET AL.	
	Examiner	Art Unit	
	Alexander Markoff	1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-13,15,17 and 19-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-13,15,17 and 19-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. It is again noted that the instant claims are directed to distinct invention, which could be properly restricted. No restriction requirement is made this time because the same prior art applied to both inventions. However, the applicants are advised that if the claims would be amended to put a serious burden on the examiner in the examining both inventions together a requirement could be made.

Double Patenting

2. Applicant is advised that should claim 3 would be found allowable, claim 4 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

> applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 6, 8, 9, 15, 17, 19, 20, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Koretsky et al (US Patent No 5,368,054).

Koretsky et al teach a method and the apparatus as claimed. See entire document, especially Figures 1-5 and the related description. The document teaches all the specifically claimed parameters of the process and all the structural limitations of the claimed apparatus. The apparatus is fully capable of cleaning the claimed objects.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 5, 7, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koretsky et al in view of Yoshitani et al (US Patent No 5,975,098).

Koretsky et al do not teach application of the liquid at oblique angle.

However, such application was conventional in the art as evidenced by Yoshitani et al. See entire document especially Figures 2a, 5, 6, 11, 13, 17, 18, 20, 21, 22 and the related description.

It would have been obvious to an ordinary artisan at the time the invention was made to apply the jet in the method and apparatus of Koretsky et al at an oblique angle in order to enhance cleaning because Yoshitani et al teach that it would result in improving of the cleaning.

Koretsky et al do not teach carriers as claimed.

However, such carriers were conventional in the art as evidenced by Yoshitani et al.

It would have been obvious to an ordinary artisan at the time the invention was made to employ the carriers of Yoshitani in the apparatus of Koretsky et al in order to

adapt the apparatus of Koretsky et al for cleaning different objects with reasonable expectation of adequate results.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koretsky in view of Yoshitani et al as applied to claims 23 and 26 above, and further in view of Thrasher et al (US Patent No 5,745,946).

Koretsky et al modified by Yoshitani et al do not specifically teach the use of a conveyor belt. They teach the use of rollers and other transporting devices.

Thrasher et al teach that the use of belt conveyors was conventional in the art and teach them as analogs of the devices of modified Koretsky et al et al. See at lest, column 1, line 65 – column 2, line 2.

It would have been obvious to an ordinary artisan at the time the invention was made to use a belt conveyor for it's conventional purpose in the modified apparatus of Koretsky et al because Thrasher et al teach this device and the ones disclosed by Yoshitani et al as analogs, which are conventionally used for the same purpose.

Practicing cleaning which such modified apparatus would obviously result in the claimed method.

10. Claims 11, 13, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koretsky et al in view of Busnaina (US2001/0013355).

Koretsky et al do not specifically teach cleaning of the specific article claimed.

Busnaina teaches part [0002] that the same megasonic cleaning methods are conventionally applied for the claimed articles and the articles specifically disclosed by Yoshitani et al. It would have been obvious to an ordinary artisan at the time the invention was made to clean the articles disclosed by Busnaina by the method of Yoshitani et al with reasonable expectation of success because Busnaina teaches that this articles can be cleaned by the same methods as the articles disclosed by Yoshitani et al.

11. Claim 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koretsky et al in view of Yoshitani et al further in view of Thrasher et al as applied to claim 10 above, and further in view of Busnaina (US2001/0013355).

Yoshitani et al modified by the teaching of Thrasher et al do not specifically teach cleaning of the specific article claimed.

Busnaina teaches part [0002] that the same megasonic cleaning methods are conventionally applied for the claimed articles and the articles specifically disclosed by Yoshitani et al. It would have been obvious to an ordinary artisan at the time the invention was made to clean the articles disclosed by Busnaina by the modified method of Yoshitani et al with reasonable expectation of success because Busnaina teaches that this articles can be cleaned by the same methods as the articles disclosed by Yoshitani et al.

Response to Arguments

12. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buker et al US Patent No 5,980,647 is cited to show the state of the prior art with respect to cleaning method and apparatuses utilizing focused ultrasound.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alexander Markoff
Primary Examiner
Art Unit 1746

am

ALEXANDER MARKOFF
PRIMARY EXAMINER